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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,489	06/30/2003	Lloyd Frink	2031.3	3330

7590 07/01/2005

Law Offices of Albert S. Michalik, PLLC
Suite 193
704-228th Avenue NE
Sammamish, WA 98007

EXAMINER

COUSO, JOSE L

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,489

Applicant(s)

FRINK ET AL.

Examiner

Jose L. Couso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8 and 10 of U.S. Patent No. 6,594,390. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed towards the same subject matter.

A comparison of the claims follows.

Claim 1 of the present application recites: In a computer system, a method comprising: (claim 1 of U.S. Patent No. 6,594,390 recites: A computer-implemented method, comprising:); Claim 1 of the present application recites: receiving pen input in an input area of digitizer (claim 1 of U.S. Patent No. 6,594,390 recites: receiving handwriting comprising pen input at a manager program); Claim 1 of the present application recites: converting, in a software program, the pen input into a key event (claim 1 of U.S. Patent No. 6,594,390 recites: converting the pen input into a key event); Claim 1 of the present application recites: and providing the key event to an application

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program, the application program separate from the software program such that the application program need not process the pen input (claim 1 of U.S. Patent No. 6,594,390 recites: and feeding the key event from the manager program separate from the application such that the application need not process the handwriting).

Claim 2 of the present application recites: wherein the key event corresponds to a character (claim 8 of U.S. Patent No. 6,594,390 recites: wherein the key event corresponds to a character).

Claim 3 of the present application recites: wherein the key event corresponds to a gesture (claim 8 of U.S. Patent No. 6,594,390 recites: wherein the key event corresponds to a character, a character being an obvious gesture).

Claim 4 of the present application recites: wherein the pen input comprises a single stroke (claim 8 of U.S. Patent No. 6,594,390 recites: wherein the key event corresponds to a character, it is obvious that certain characters comprise a single stroke).

Claim 5 of the present application recites: wherein the pen input comprises at least two strokes (claim 8 of U.S. Patent No. 6,594,390 recites: wherein the key event corresponds to a character, it is obvious that certain characters comprise at least two strokes).

Claim 6 of the present application recites: wherein converting the pen input into a key event includes calling a recognizer (claim 10 of U.S. Patent No. 6,594,390 recites: wherein converting the pen input into a key event includes calling a recognizer).

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Claim 7 of the present application recites: detecting the end of the pen input (claim 2 of U.S. Patent No. 6,594,390 recites: wherein receiving handwriting includes detecting the end of the pen input).

Claim 8 of the present application recites: wherein detecting the end of the pen input includes detecting a pen up event (claim 3 of U.S. Patent No. 6,594,390 recites: wherein detecting the end of the pen input includes detecting a pen up event).

Claim 9 of the present application recites: wherein detecting the end of the pen input includes detecting that pen input has stopped for a period of time (claim 4 of U.S. Patent No. 6,594,390 recites: wherein detecting the end of the pen input includes detecting that pen input has stopped for a period of time).

Claim 10 of the present application recites: wherein detecting the end of the pen input includes detecting a particular pen action (claim 8 of U.S. Patent No. 6,594,390 recites: wherein detecting the end of the pen input includes detecting a particular pen action).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sklarew (U.S. Patent No. 4,972,496).

With regard to claim 1, describes receiving pen input in an input area of digitizer (see for example figures 1 and 3, elements 14 and 16, and refer for example to column 5, lines 57-59); converting, in a software program, the pen input into a key event (see for example figure 4, elements 16, 64, 50 and 54, and refer for example to column 9, line 16 through column 12, line 37); and providing the key event to an application program, the application program separate from the software program such that the application program need not process the pen input (refer for example to column 10, lines 21-57 and column 12, lines 7-63). The stylus in Sklarew enters the information, the microprocessor then sends the information to handwriting recognition processing which makes use of the handwritten information (as discussed in column 11, lines 1-51). Elements 54 in figure 4 is a ROM which programmed with the operating and application programs (as mentioned in column 8, lines 30-32). The output of the handwriting recognition is then used for word processing and telecommunication applications (as describes in column 11, lines 9-14).

As to claim 2, describes wherein the key event corresponds to a character (as described for example in column 11, lines 15-22).

In regard to claim 3, describes wherein the key event corresponds to a gesture (refer for example to column 11, lines 33-34, a numeral in Sklarew correspond to applicant's gesture).

With regard to claim 4, describes wherein the pen input comprises a single stroke (refer for example to column 11, line 35, the period or comma of Sklarew comprises a single stroke).

As to claim 5, describes wherein the pen input comprises at least two strokes (refer for example to column 11, lines 35-36, the colon or semi-colon of Sklarew comprises at least two strokes).

In regard to claim 6, describes wherein converting the pen input into a key event includes calling a recognizer (as described for example in column 11, lines 1-51).

With regard to claim 7, describes detecting the end of the pen input (see for example figure 5, element 76, the no decision indicates end of the handwritten data).

As to claim 8, describes wherein detecting the end of the pen input includes detecting a pen up event (see for example figure 5, element 76, the no decision indicates end of the handwritten data by detecting that the pen is up).

In regard to claim 9, describes wherein detecting the end of the pen input includes detecting that pen input has stopped for a period of time (as clearly illustrated in figure 5, elements 75 and 76).

With regard to claim 10, describes wherein detecting the end of the pen input includes detecting a particular pen action (refer for example to column 5, lines 57-67 and column 7, lines 20-50).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hardin, Sr. et al., Ross, Togawa et al., Norwood all disclose systems similar to applicant's claimed invention. Frink et al. ('406), ('423) and ('187) all disclose applicant's inventions.

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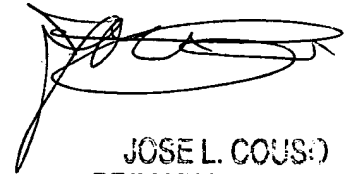
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (571) 272-7388. The examiner can normally be reached on Monday through Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso, can be reached on (703) 272-7695. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the USPTO contact Center whose telephone number is (703) 308-4357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jlc
June 7, 2005



JOSE L. COUSO
PRIMARY EXAMINER